

### **Remarks**

This communication is considered fully responsive to the Office Action mailed January 7, 2005. Claims 1-24 were examined. Claims 1-24 stand rejected. No claims are amended. No claims are canceled. No new claims have been added. Reexamination and reconsideration of claims 1-24 are respectfully requested.

### **Information Disclosure Statement**

Applicant respectfully requests consideration of the supplemental information disclosure statement submitted herewith.

### **Claim Rejections - 35 U.S.C. 102(b)**

The Office Action rejected claims 1-6, 8, 13-16, and 20-24 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,754,308 to Lopresti, et al. (hereinafter referred to as "Lopresti"). Applicant respectfully traverses this rejection.

Claim 1 positively recites "sending a document from a multifunction device; and recording delivery data for said sent document in said remote document history repository when said document is sent from said multifunction device . . ." (emphasis added). Lopresti fails to disclose at least these recitations.

Lopresti discloses encoding document information designators having information regarding the location of digital representations of the page, and optionally page generation and reproduction information, so that a copier or fax

machine can retrieve the stored digital representation to output a “subsequent original” of the page, as opposed to traditional photocopying or faxing of the page. Lopresti fails to disclose sending a document from a multifunction device and then recording delivery data for the sent document in a remote document history repository.

The Office Action cites generally to Figure 4, col. 6, lines 20-34, and col. 7, line 56 to col. 8, line 34 as disclosing the recitations of claim 1. However, Figure 4 is simply a high level diagram showing a computer network with a document database. Col. 6, lines 20-34 describes the ability to retrieve successive versions of a stored page or pages of a document and then recreating the page (e.g., by printing it at the copier). Col. 7, line 56 to col. 8, line 34 describes a method of entering digital representations of pages into the archives along with DocIDs for the pages. The DocIDs identify the storage location at which the digital representation of the page is stored, and “may also include identification of the person who generated the page, input location, input parameters, indicia for identifying the page, a page count for multipage documents, archive destination information, and cyclic redundancy check (CRC) and error correcting codes (ECC).” However, nowhere in these citations does Lopresti disclose, much less even teach or suggest, sending a document from a multifunction device and then recording delivery data for the sent document in a remote document history repository.

For at least the foregoing reasons, claim 1 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 1.

Claims 2-13 depend from claim 1, which is believed to be allowable. Therefore, claims 2-13 are also believed to be allowable for at least the same reasons as claim 1 and withdrawal of the rejection of claims 2-13 is respectfully requested.

In addition, claim 2 positively recites “accessing said remote document history repository to track document flow.” Lopresti also fails to disclose at least these recitations. The Office Action relies on col. 8, lines 14-34 as disclosing these recitations. Although this citation explains that the archive server may provide storage management, document management, security, and accounting functions relative to the pages, there is no disclosure of accessing a remote document history repository to track document flow. Claim 2 is believed to be allowable for at least these reasons.

Claim 4 positively recites “updating said remote document history repository to indicate receipt of said sent document.” Lopresti also fails to disclose at least these recitations. The Office Action relies on col. 8, lines 30-34 as disclosing these recitations. Again, while this citation explains that the archive server may provide storage management, document management, security, and accounting functions relative to the pages, there is no disclosure of updating a remote document history repository to indicate receipt of said sent document. Claim 4 is believed to be allowable for at least these reasons.

Claim 6 positively recites “resending said document.” Lopresti also fails to disclose at least these recitations. The Office Action states in paragraph 3 that “sending a document from a multifunction device [is] an inherent feature since the document must get from the input device to the archive server.” In

order to be consistent with this interpretation of Applicant's claim, Lopresti must disclose resending the document to the archive server in order to anticipate claim 6. The Office Action's citation to col. 1, lines 58-67 fail to disclose this recitation. Claim 6 is believed to be allowable for at least these reasons.

Claim 14 positively recites "sending an electronic document from a multifunction device; and recording delivery data for said sent electronic document in said remote document history repository after said electronic document is sent from said multifunction device . . . " (emphasis added). As discussed above for claim 1, at least these recitations are not disclosed in the cited references. Therefore, claim 14 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 14.

Claims 15-16 depend from claim 14, which is believed to be allowable. Therefore, claims 15-16 are also believed to be allowable for at least the same reasons as claim 14 and withdrawal of the rejection of claims 15-16 is respectfully requested.

In addition, claim 15 positively recites "updating said remote document history repository to indicate receipt of said sent electronic document." At least these recitations are not disclosed in the cited references, as discussed above for claim 4. Claim 15 is believed to be allowable for at least these reasons.

Claim 20 positively recites "application software on a computer readable media for recording delivery data in a remote document history repository when a document is sent from said multifunction device . . . " (emphasis

added). As discussed above for claim 1, at least these recitations are not disclosed in the cited references. Therefore, claim 20 is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 20.

Claims 21-24 depend from claim 20, which is believed to be allowable. Therefore, claims 21-24 are also believed to be allowable for at least the same reasons as claim 20 and withdrawal of the rejection of claims 21-24 is respectfully requested.

#### **Claim Rejections - 35 U.S.C. 103(a)**

The Office Action rejected claims 9 and 17 under 35 U.S.C. 103(a) as being unpatentable over Lopresti in view of U.S. Patent No. 6,584,466 to Serbinis, et al. (hereinafter referred to as "Serbinis"). Applicant respectfully traverses this rejection.

Claim 9 depends from claim 1 and claim 17 depends from claim 14. Claims 1 and 14 are each believed to be allowable as discussed above. Therefore claims 9 and 17 are also believed to be allowable for at least the same reasons as the respective independent claims. Withdrawal of the rejection of claims 9 and 17 is respectfully requested.

The Office Action rejected claims 11 and 19 under 35 U.S.C. 103(a) as being unpatentable over Lopresti in view of Serbinis. Applicant respectfully traverses this rejection.

Claim 11 depends from claim 1 and claim 19 depends from claim 14. Claims 1 and 14 are each believed to be allowable as discussed above.

Therefore claims 11 and 19 are also believed to be allowable for at least the same reasons as the respective independent claims. Withdrawal of the rejection of claims 11 and 19 is respectfully requested.

In addition, claim 11 positively recites “monitoring receipt of said document” and “resending said document after a predetermined time based on delivery data recorded in said remote document history repository.” Claim 19 includes similar recitations. The Office Action admits Lopresti does not disclose resending the document after a predetermined time and instead relies on Serbinis at col. 10, lines 35-54 and col. 18, line 22 to col. 19, line 30 as disclosing these recitations. The citation at col. 10, lines 35-54 discloses generating messages notifying users that a document is available, but does not disclose monitoring receipt of a document and resending the document after a predetermined time. The citation at col. 18, line 22 to col. 19, line 30 also fails to disclose monitoring receipt of a document and resending the document after a predetermined time.

Apparently recognizing the deficiency in Serbinis, the Office Action states “the office takes the term ‘predetermined time’ to be construed as ‘a predetermined event’.” The Office Action is impermissibly redefining a well known term (i.e., time) as something entirely different (i.e., “a predetermined event, such as the receipt of a notification email and establishment of a user session by the recipient”). Therefore, the Office Action has failed to make a prima facie case of obviousness. See MPEP at §2143.03 (mandating that all claim recitations be taught or suggested by the prior art).

Claims 11 and 19 are believed to be allowable for at least these reasons.

The Office Action rejected claims 10 and 18 under 35 U.S.C. 103(a) as being unpatentable over Lopresti in view of U.S. Patent No. 5,893,908 to Cullen, et al. (hereinafter referred to as “Cullen”). Applicant respectfully traverses this rejection.

Claim 10 depends from claim 1 and claim 18 depends from claim 14. Claims 1 and 14 are each believed to be allowable as discussed above. Therefore claims 10 and 18 are also believed to be allowable for at least the same reasons as the respective independent claims. Withdrawal of the rejection of claims 10 and 18 is respectfully requested.

In addition, claim 10 positively recites “notifying a sender of said document that said document is undeliverable.” Claim 18 includes similar recitations. The Office Action admits Lopresti does not disclose these recitations and instead relies on Cullen. Cullen discloses document database queries at col. 5, line 55 to col. 6, line 45 (cited in the Office Action), and a digital copier that alerts a user when a document to be copied already exists electronically within a database (col. 6, lines 48-63). However, Cullen fails to disclose notifying a sender of a document that the document is undeliverable.

Claims 10 and 18 are believed to be allowable for at least these reasons.

The Office Action rejected claims 7 and 12 under 35 U.S.C. 103(a) as being unpatentable over Lopresti in view of U.S. Patent No. 5,978,477 to Hull, et al. (hereinafter referred to as “Hull”). Applicant respectfully traverses this rejection.

Claims 7 and 12 depend from claim 1. Claim 1 is believed to be allowable as discussed above. Therefore claims 7 and 12 are also believed to be

allowable for at least the same reasons as claim 1 and withdrawal of the rejection of claims 7 and 12 is respectfully requested.



**Conclusion**

The Applicant respectfully requests that a timely Notice of Allowance be issued in this matter.

Respectfully Submitted,

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